

Remarks

For the Claims:

Claims 1, 3-8, 10, 12-23, and 25-40 are pending in this application. Claims 1, 10, 23 and 37 are the only independent claims. Claims 1 and 37 are amended herein by adding into the bodies of the claims the phrase --in said data processing system-- , which refers to a similar phrase already recited in the preambles of the respective claims.

In addition, claims 10 and 23 are amended herein for consistency with the language of claim 1. In particular, terminology concerning the use of the phrases "issuer code" and "identifier code" have been made more definite. This change necessitated incorporating limitations from claims 11 and 24 into claims 10 and 23, respectively, and claims 11 and 24 have been cancelled.

Moreover, claim 8 listed above in the claim listing is the true original claim 8. In the previous amendment, a listing of claims mistakenly indicated that a duplicated version of claim 7 was the original claim 8. That mistake is corrected herein.

This Amendment After Final does not raise new issues/matter that require further consideration and/or search. Rather, the present amendment clarifies issues for appeal. Entry of this Amendment After Final is respectfully requested.

The Final Office Action rejected claims 1, 3-8 and 10-40 under 35 U.S.C. 101, alleging that the claimed invention was

directed to non-statutory subject matter. The Final Office Action also recommended that the claims be amended to clarify which of the steps are performed by a computer or server. The below-signed attorney appreciates the time taken by the examiner on 6 July 2005 to discuss over the phone a proposed solution to this issue. That proposed solution is implemented herein. In particular, claims 1 and 37 have each been amended to recite, in the body of each claim that the "identifying" step of each claim is performed in "said data processing system". Thus, claims 1 and 37 each clearly indicate a connection to a computer or technology, and it is clear that this step in each claim cannot be performed manually by a person.

Accordingly, applicant believes that the 35 U.S.C. 101 rejection of independent claims 1 and 37 has been overcome. Likewise, since dependent claims 3-8, 31 and 32 depend from claim 1 and claims 38-40 depend from claim 37, and since the limitations of the respective independent claims are incorporated into the dependent claims, applicant believes that the 35 U.S.C. 101 rejection of dependent claims 3-8, 31, 32, and 38-40 has also been overcome. Reconsideration is respectfully requested.

The Final Office Action rejected claims 1, 3, 10, 12, 23, and 25 as being anticipated under 35 U.S.C. §102(b) by Levine, et. al. (WO95/12169, hereinafter "*Levine*"). And, claims 4-8, 13-22, and 29-40 were rejected under 35 U.S.C. §103(a) as being obvious over *Levine* in combination with Boston (EP0251619, hereinafter "*Boston*"). Thus, all claims pending in the present application were rejected over either the *Levine* prior art reference or the *Levine* prior art reference in combination with the *Boston* reference.

Applicant respectfully requests reconsideration. *Levine* simply fails to teach that which the Final Office Action alleges is taught, and *Boston* fails to teach the missing parts from *Levine*.

The present invention is concerned with effecting transactions in a multicurrency environment. Within the context of the present invention, for any individual merchant, individual transactions may take place using any one of a number of different currencies. As is discussed in more detail below, applicant's claims define an invention that permits a transaction which takes place between a merchant and a customer using a payment card to take place using the customer's preferred currency. Neither *Levine* nor *Boston* disclose such a system, as each discloses a system in which transactions take place exclusively in the currency of the merchant.

While this lack of teaching by *Levine* and *Boston* defeats any prima facie case against applicant's claims based on *Levine* and/or *Boston*, the below-presented discussion will also show how the claimed invention achieves another goal not considered, taught, or suggested by *Levine* and/or *Boston*. In particular, the claimed invention not only permits a transaction to take place in a currency friendly to the customer, but it also makes the selection of that currency automatic. Time need not be wasted during the transaction process to identify the customer's preferred currency and to set-up the transaction equipment to process the transaction in that currency. The automatic selection process also reduces mistakes and saves time that would be needed to correct mistakes when compared to other systems that might involve humans in a currency-selection process. Again, neither *Levine* nor *Boston* disclose such a system, as each discloses systems in which transactions take place exclusively in

the currency of the merchant and no automatic currency selection takes place.

Portions of applicant's independent claims 1, 10, and 23 are presented below for review:

Claim 1:

setting the currency for association with the payment card transaction as the determined operating currency for the identifier code.

Claim 10:

means for setting the currency for association with the payment card transaction as the determined operating currency for the identifier code.

Claim 23:

a computer code section which when executed on the computing device sets the currency for association with the payment card transaction as the determined operating currency for the identifier code.

These three different independent claims recite different limitations, as set forth above. But for the purposes of this argument the above-presented limitations have something in common. Namely, a currency is set for association with the transaction, and the currency is set in response to the identifier code obtained from the payment card. For the purposes of this argument, this common feature will be referred to as an "automatic-currency-setting" feature, but for all other purposes reference should be made to the claim language itself.

Neither *Levine* nor *Boston* teach or suggest applicant's claimed automatic-currency-setting feature. *Levine* teaches a method and apparatus for distributing currency. *Levine* specifically teaches a magnetic stripe, electronic traveler's

check (ETC) card issued to a customer and having a customer-selectable monetary value. The customer-selectable monetary value is configured with an encoded card number, including a bank identification number (BIN) and an account number. A particular bank may have multiple BIN numbers for multiple types of currencies in which cards can be issued. A database will know the currency of the card from the BIN number for that card number stored in its database.

The ETC taught by *Levine* is unrelated to charge, debit, or credit cards. It is limited to allowing persons who have purchased the ETC to make cash withdrawals or cash transfers from automatic teller machines (ATM's) or other cash-dispensing terminals (see *Levine* at the abstract and page 3 lines 2 to 11).

Levine contemplates use of the ETC in a multicurrency environment. In a multicurrency currency environment, the ATM machine with which the ETC is being used sends the ETC's BIN and a code indicating the currency of the ATM to a "VisaNet" computer. Thus, two different currencies may be involved, one for the ATM and another for the ETC. *Levine's* VisaNet computer then provides any currency conversion needed (see *Levine* at page 7 lines 29-33). This is the opposite of what applicant claims. A currency conversion is needed in *Levine* because the *Levine* transaction is performed exclusively using the ATM's currency. Nothing in *Levine* teaches or suggests any feature that would allow the transaction to be performed using any other currency than that of the ATM. If *Levine* permitted the transaction to take place in the ETC's currency, then in contrast to the teaching of *Levine*, no currency conversion would need to take place.

Levine clearly teaches away from applicant's claimed automatic-currency-setting feature by needing a currency conversion that always causes the transaction to take place in the currency of the ATM machine and never in the currency of the ETC. Any interpretation of *Levine* as having the automatic-currency-setting feature clearly comes from applicant's specification and not from the text and figures of *Levine*. This is strong evidence of an impermissible use of hindsight reconstruction of the prior art using applicant's specification. Such a hindsight reconstruction is not permitted.

Boston teaches a transaction card, which is configured with a microprocessor and a memory (see *Boston* at page 7, references 20, 22, 24, and 30) in which to store a transaction limit and exchange rates. The *Boston* card is further configured with data entry means (see *Boston* at page 8 reference 28) with which to update the limit and rates. *Boston* further teaches methods of approving a transaction value, including a transaction involving an alternative currency.

Like *Levine*, the transaction currency in *Boston* remains that of the merchant in all cases. The *Boston* card only roughly calculates the transaction amount between the issuer's base currency and the local, alternative currency of the merchant for purposes of approval.

Moreover, in *Boston* the currency of the merchant must be manually selected by the cardholder (page 11, lines 5 to 7) because the card stores exchange rates, not the terminal. *Boston* fails to teach inputting a card number (i.e., the number applied to the card at manufacturing time) in a terminal by way of data input means. There are no teachings in *Boston* pertaining to identifying an identifier code from the card number, nor does

Boston teach of determining the operating currency for the issuer code or setting the determined operating currency as the preferred transaction currency.

Accordingly, *Boston*, like *Levine*, fails to teach the automatic-currency-setting feature set forth in applicant's claims 1, 10 and 23. Since neither *Levine* nor *Boston* teach this feature, no combination of the *Levine* and *Boston* references can provide a teaching or even a suggestion of applicant's claimed automatic-currency-setting feature. Claims 1, 10, and 23 are therefore deemed allowable. Reconsideration is respectfully requested.

Since claims 3-8 and 31-32 depend from claim 1, claims 12-22 and 33-34 depend from claim 10, and claims 24-30 and 35-36 depend from claim 23, they too are deemed allowable for the reasons set forth above.

The Final Office Action rejected independent claim 37 and claims 38-40 which depend therefrom as being obvious over *Levine* in combination with *Boston*. A portion of independent claim 37 is reproduced below for review:

Claim 37:

indicating said operating currency as being a preferred currency of exchange for said financial transaction;
receiving a cardholder reply in response to said indicating activity; and
completing said financial transaction in response to said receiving activity.

As discussed above, *Boston* teaches nothing beyond *Levine* with respect to completing a financial transaction using the payment card's currency, which is called a "base currency" in

Boston. Like *Levine*, *Boston* teaches completing a financial transaction using only the currency of the merchant. Nothing is taught or suggested about conducting a financial transaction using the payment card's currency. For this reason alone, claim 37 is deemed allowable over *Levine* and *Boston*, either alone or in combination with one another.

In addition, the Final Office Action acknowledged that *Levine* failed to disclose the "indicating" activity recited above, but then mistakenly interpreted *Boston* as teaching this "indicating" activity. The Final Office Action further cited page 12 paragraphs 2-4 of *Boston* as providing that specific teaching. But *Boston* teaches or suggests no such thing, either in the cited passage or elsewhere. The cited passage in *Boston* (i.e., page 12 paragraphs 2-4) discusses a process for loading a conversion rate into the card. This process has nothing to do with using the card to engage in a transaction. This misinterpretation of *Boston* as teaching what it clearly does not teach can only have been made through the impermissible use of hindsight where that which applicant teaches is improperly attributed to the prior art.

The *Boston* smart card does have a display 50, and it can be used to engage in a financial transaction in a multicurrency environment. But *Boston* teaches that all such financial transactions are to be conducted using only the merchant's currency. In connection with that transaction in the merchant's currency, a block 206 may be performed to select a desired currency (i.e., the merchant's currency). This feature is discussed in *Boston* on page 14. A desired currency is selected through a conventional menu structure. Nothing discloses or suggests that any one currency is ever indicated as being a preferred currency of exchange for the financial transaction,

And, certainly nothing discloses or suggests that "said operating currency" is to be indicated. In accordance with claim 37, "said operating currency" is determined from an identifier code, which is identified from a card number, and the card number is obtained from the payment card. Moreover, nothing in *Boston* discloses or suggests receiving a cardholder reply in response to an indicating activity that does not exist or, completing the transaction in response to the receiving activity that receives a cardholder reply to the card's-currency-indicating activity. These teachings come from only applicant's specification.

Thus, claim 37 recites steps that go far beyond anything disclosed or suggested in either *Levine* or *Boston*. And, together they cannot be interpreted to suggest what neither alone suggests.

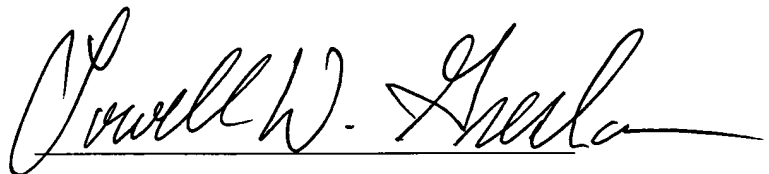
Furthermore, the Final Office Action fails to provide any motivation or explanation as to why one skilled in the art would be motivated to combine the *Levine* system with the *Boston* smart card. This failure results because no such motivation exists. For one thing, *Levine* and *Boston* teach systems built around vastly different and incompatible technologies. *Levine* teaches a magnetic-stripe-card-based system while *Boston* teaches a smart-card-based system. Those skilled in the art will know that the capabilities of a smart-card-based system cannot simply be incorporated into a magnetic-stripe-card-based system because the capabilities of the technologies are so vastly different. Moreover, *Levine* teaches a system that relies on the use of a central processor, such as *Levine's* "VisaNet" computer. On the other hand, *Boston* expressly teaches a system having an object of generating an approval of a transaction in a foreign currency without connection to a central processor (see *Boston* at page 5 lines 4-8). One skilled in the art would not selectively pick

and choose features from a system whose express object is to operate without a central processor for combination into a system that is built around just that -- a central processor.

For the above reasons, claim 37 is deemed allowable over *Levine* and *Boston*, either alone or in combination with each other. Likewise, claims 38-40, which depend from claim 37, are deemed allowable for the same reasons. Reconsideration is respectfully requested.

Applicant believes that the foregoing amendments and remarks are fully responsive to the rejections and/or objections recited in the 2 May 2005 Office Action and that the present application is now in a condition for allowance. Accordingly, reconsideration of the present application is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, reading "Lowell W. Gresham". The signature is fluid and cursive, with a long horizontal line extending from the end of the name.

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